

REMARKS

This application has been carefully reviewed in view of the above-referenced Office Action, and reconsideration is requested in view of the following remarks. No amendments are made herein, but the claims are presented above for the Examiner's convenience.

Regarding the Rejections Under 35 U.S.C. §103

Claims 9, 10, 15-17, 28-30, 32, 33, 58-61, 63 and 64 were rejected based on the combination of Candelore and Lu of record. It is noted that Candelore is an inventor of the present application and is the same Brant Candelore. These rejections are respectfully traversed.

In order to establish *prima facie* obviousness of the claims, it is the Patent Office's burden to apply the Graham v. John Deere, 383 U. S. 1 (1966) framework for applying the statutory language of §103 in making an objective analysis of obviousness. The Court stated that "under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented."

The Patent Office further has the burden of providing an articulated reasoning why one of ordinary skill in the art would find the proposed combination to be obvious per In re Kahn, 441 F. 3d 977, 988 (CA Fed. 2006 – recently cited by the SCOTUS) - "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"). It is further noted that MPEP2141.02 clearly requires that the claim be considered as a whole. Such consideration requires that each and every claimed feature as well as its interconnection and relationship with the other features be considered in evaluation of the differences in the claim and the prior art as required in the Graham inquiries.

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Applicant notes several distinctions between the cited art and the claims at issue. Considering by way of example claim 58 and the claims dependent thereupon, the Office asserts that Candelore discloses "a PID remapper within the device that selects certain of the packets for remapping...". However, it is noted that the claim at issue calls for "a PID remapper within the CableCARD device that selects certain of the packets for remapping..." (emphasis added). Candelore discloses PID remapping, but does not disclose that such remapping can be done inside a CableCARD device as claimed. Candelore has no such feature disclosed and can in certain implementations provides the benefit of enabling retrofit of CableCARD compatible devices to operate in a system using selective multiple encryption without modification of the host device. The Office has erred in at least improperly ignoring this claim feature which is found in neither Candelore nor Lu. In order to establish *prima facie* obviousness, the Office has the burden of establishing that this feature is either directly shown, taught or suggested in the prior art, or per *In Re Kahn supra*, provide an articulated reasoning that explains why one of ordinary skill in the art would find the feature obvious. In view of this error, *prima facie* obviousness has not been established. Reconsideration and allowance of claim 58 and all claims dependent thereon are respectfully requested.

Regarding independent claims 63 and 64, claim 63 explicitly calls out that all functions are carried out "in the CableCARD device" and claim 64 explicitly calls out that the PID remapper is in the CableCARD device using the same language as claim 58. Accordingly, it is submitted that these claim features have also been improperly ignored, and no articulated reasoning for their obviousness has been presented as required. Hence, claims 63 and 64 are submitted to be allowable as presented. Reconsideration and allowance of claims 63 and 64 and all claims dependent thereupon are respectfully requested.

Claims 8, 18, 31 and 62 were rejected on the combination of Candelore and Lu as above and further in view of Sadafi. For all the reasons noted above, these claims have not been established to be *prima facie* obvious. Sadafi has not provided the missing teaching necessary to

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remedy the deficient combination of Candelore and Lu. Hence reconsideration and allowance are respectfully requested.

Specifically regarding the use of the Hodges reference in connection with claims 11, 12, 34 and 35 in combination with Candelore and Lu, the above comments are applicable regarding the deficiencies of Candelore combined with Lu. Hodges fails to provide any teaching that remedies these deficiencies. Accordingly, reconsideration and allowance of these claims are respectfully requested.

Several of the remarks made in the prior response regarding the Lu reference remain applicable and are incorporated in this response by reference thereto.

Concluding Remarks

The undersigned notes that many other distinctions exist between the cited art and the claims. However, in view of the clear distinctions pointed out above, further discussion is believed to be unnecessary at this time since it is the Office's burden to establish *prima facie* obviousness under the guidelines established by the above-cited authorities. Failure to address each point raised in the Office Action should accordingly not be viewed as accession to the Examiner's position or an admission of any sort. Applicant reserves the right to make further arguments in the future regarding any rejection if he deems such arguments advantageous.

Interview Request

In view of this communication, all claims are now believed to be in condition for allowance and such is respectfully requested at an early date. If further matters remain to be resolved, the undersigned respectfully requests the courtesy of an interview. The undersigned can be reached at the telephone number below.

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Respectfully submitted,

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